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| 10/017,831   | 12/07/2001  | Joseph A. Manico             | 83565SLP            | 5035                   |
| 7590 12/13/2007  |             |                              |                     |                        |
| Thomas H. Close<br>Patent Legal Staff<br>Eastman Kodak Company<br>343 State Street<br>Rochester, NY 14650-4027 |             | EXAMINER<br>HANNETT, JAMES M |                     |                        |
|  |             | ART UNIT<br>2622             |                     | PAPER NUMBER           |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/017,831

Applicant(s)

MANICO ET AL.

Examiner

James M. Hannett

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-11 and 13-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-7,9-11,13-22, 24, 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 1,23 and 25-28 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/5/2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The applicant is advised to file a proper IDS for the submitted article titled "A survey of digital minilabs in the USA" by Photoreporter. No. 11, Vol. 14, June 11, 2006.

### ***Response to Arguments***

Applicant's arguments, see pre-appeal brief request, filed 9/10/2007, with respect to claims 1, 23 and 25-31 have been fully considered and are not persuasive.

The applicant argues that the fact that the imaging system of Ueda et al teaches that the imaging system is movable using the depicted wheels does not indicate portability. The examiner disagrees with the applicant. Clearly the imaging system of Ueda et al was designed to have wheels because it was desirable to make the system movable. Furthermore, although this system is not small enough to be moved by hand, the examiner took Official Notice that it would have been notoriously obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the imaging system of Ueda et al in order to make it small enough to be carried by hand. The examiner asserts that Ueda et al discloses the claimed invention except for being hand held and portable. It would have been an obvious matter of design choice to make the imaging system of Ueda et al small enough to be carried by hand, since such a modification

would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Furthermore, the examiner asserts that it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

Furthermore, the applicant has argued that no prior art exists that has enabled a successful deduction of a wet-processing minilab to be hand-held and a portable size. Furthermore, the applicant provided an article titled "A survey of digital minilabs in the USA" by Photoreporter. No. 11, Vol. 14, June 11, 2006. The applicant then asserts that none of the described mini-labs are hand-held. Therefore, concludes that reducing one to a size that is hand-held would not be obvious.

The examiner disagrees with the applicant and points out that although the applicant asserts that the provided reference Photoreporter does not teach a minilab that is hand-carriable, this is incorrect. Photoreporter describes on Page 4, Line 9-11 that tabletop SP500 scanner has a footprint of 1X2 feet and weighing less than 50 pounds. The examiner asserts that a device that is less than 50 pounds and is 1 foot by 2 feet is a hand-carriable device. Although The Photoreporter reference is not prior art, it shows that Current mini-labs are a size small enough to be carried by hand. Therefore, the examiner reiterates that A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). Furthermore, the examiner asserts that it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine in the art. In re Lindberg, 93 USPQ 23 (CCPA 1952).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1:** Claims 1, 23, 25, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al.

**2:** As for Claim 1, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image, comprising the steps of: The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the second location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the second location (photo-shop) using the portable imaging system to produce a digital image; Ueda et al teaches on Column 36, Lines 55-67 and Column 38, Lines 1-9 that the photo-shop operator will take credit card information and order request information from a customer, this is viewed as the service provider receives an order request associated with the digital image from the user. Furthermore, Ueda et al depicts in Figure 9 and teaches on

Column 71, Lines 10-50 that if the photo-shop is unable to perform all of the desired imaging services the images can be transmitted to the main photo-finishing center or a truck will arrive at the photo-shop and pickup the images and bring them to the photo-finishing processing center. This is viewed as the service provider providing the digital images to a fulfiller (photo-finishing center) for fulfillment of the order request. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system from a first location to a second location. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to be hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

- 3: As for Claim 23, Claim 23 is rejected for reasons discussed related to Claim 1.
- 4: As for Claim 25, Claim 25 is rejected for reasons discussed related to Claim 1.
- 5: As for Claim 26, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of producing a print from a visual image (printing out images), comprising the steps of: transporting a portable imaging system to a first location; The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a

service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed by the examiner as scanning the hard copy document at the first location using the portable imaging system to produce a digital image. The system is viewed by the examiner to be portable as a result of the wheels depicted in Figure 3. Ueda et al further depicts in Figures (3 and 5) that the portable photofinisher (600) is provided with wheels (302). Although the specification of Ueda et al does not specifically discuss the wheels or when the photofinisher will be moved, It is clear from in Figures (3 and 5) that the photofinisher is inherently designed to be moved from a first location to a second location. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to by hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

6: As for Claim 27, Ueda et al teaches on Column 1, Lines 26-35 and depicts in Figure 1, 2, and 9 a method of digitizing an image. The examiner views the process of a company installing the photographic processing apparatus in a photo-shop as a service provider transporting a portable imaging system to a first location. Ueda et al teaches on Column 36, Lines 43-60 that a customer will enter a photo-shop with photographs, negatives, and PC memory cards, etc with images on them which they want to be developed. This is viewed as the service provider receives the images to be digitized from a user at the first location. Ueda et al teaches on Column 35, Lines 37-42 that the service provider is equipped with a film scanner and a flat bed scanner, therefore the operator in the photo-shop scans the image at the first location (photo-shop) using the portable imaging system to produce a digital image. This is viewed as accessing the image to be digitized at the second location and scanning the image at the second location using the portable imaging system to produce a digital image. Ueda et al teaches on Column 36, Lines 32-60 and Column 37, Lines 34-50 that the scanned image is digitized and stored in memory. Furthermore, Ueda et al teaches generating an order request associated with the stored digital image. However, Ueda et al does not discuss the specifics of the size of the photographic processing apparatus and is silent as to if the device can be small enough to be hand held and small enough for the service provider to carry it by hand.

Official Notice is taken that it was notoriously well known in the art to reduce the size of image processing apparatus such as scanners to as small a size as possible. This is advantageous because it allows the device to take up less space and enables the device to be easily moved.



Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to reduce the size of the image processing apparatus in order to allow the device to take up less space and enables the device to be easily moved by hand.

7: Claims 28 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,429,923 Ueda et al in view of US 2004/0109147 A1 Redd et al.

8: As for Claim 29, Ueda et al teaches an imaging photo-developing system that can receive images from a user to be printed. However, does not teach that the system can record audio input corresponding to the image in the portable imaging system.

Reed et al teaches on Paragraph [106] a system for printing images and teaches that it is advantageous to enable a system to capture audio information from a user, digitizing the audio and encoding it on the back of the images that are printed. The Reed teaches that this is advantageous because it allows a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the system of Ueda et al to capture and encode audio information onto the back of the printed pictures as taught by Reed et al in order to allow a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

9: In regards to Claim 30, Ueda et al teaches an imaging photo-developing system that can receive images from a user to be printed. However, does not teach that the system can record audio input corresponding to the image in the portable imaging system.

Reed et al teaches on Paragraph [106] a system for printing images and teaches that it is advantageous to enable a system to capture audio information from a user, digitizing the audio and encoding it on the back of the images that are printed. The Reed teaches that this is advantageous because it allows a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to enable the system of Ueda et al to capture and encode audio information onto the back of the printed pictures as taught by Reed et al in order to allow a user to encode a message onto the image so that a message associated with the images can be played back at a later time and therefore, help a user better remember the contents of the captured picture.

***Allowable Subject Matter***

10: Claims 2-7, 9-11, 13-22, 24, 29 and 30 are allowed

The following is a statement of reasons for the indication of allowable subject matter: The prior art does not teach the method of transporting a portable imaging system to a first location; receiving a hardcopy document from a user at the first location, the hard copy document containing the visual image; scanning the hard copy document at the first location using the portable imaging system to produce a digital image; and transporting the portable imaging system to a second location remote from the first location. Furthermore, the prior art

does not teach the method of sequentially transporting a portable imaging system from a first location; accessing the image to be digitized at the second location; scanning the image at the second location using the portable imaging system and storing the digital image in memory disposed in the portable imaging system and generating an order request associated with the stored digital image.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Hannett whose telephone number is 571-272-7309. The examiner can normally be reached on 8:00 am to 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on 571-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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James M. Hannett  
Examiner  
Art Unit 2622



JMH  
December 10, 2007